

*Amendment and Response*  
*Serial No. 09/920,439*

### REMARKS

Before entry of this Amendment and Response, the status of the application according to the pending Office action is as follows:

- Claims 1-2, 6-7, 9-12, 16-17, and 37-42 are rejected under 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent No. 2,333,303 to Enos ("Enos").
- Claims 3-4 and 13-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Enos.
- Claims 1-2, 5, 7-12, 15, 17-20, and 37-42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,237,758 to Zachman ("Zachman") in view of U.S. Patent No. 2,557,946 to Crooker ("Crooker").

Applicants appreciate the Examiner's courtesy in granting Applicants' representatives the personal interview held on March 30, 2004. The amendments and remarks set forth herein are consistent with those discussed during the interview. In view of that interview, Applicants hereby amend claims 1 and 11 to more clearly describe the subject matter that Applicants regard as the invention. No new matter is added thereby. Applicants hereby amend claims 2, 3, 6-9, 12, 13, 16-19, and 37-42 to incorporate claim language used in amended independent claims 1 and 11. No new matter is entered thereby. Support for the amendments can be found at least in paragraphs [0014], [0015], [0023], and FIGS. 1C, 2B, and 3B.

Applicants hereby present new claims 43 and 44 for consideration. No new matter has been entered thereby. Support for these claims can be found at least in FIGS. 7 and 8.

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1. Claims 1-2, 6-7, 9-12, 16-17, and 37-42 are rejected under 35 U.S.C. § 102(b) as being unpatentable over Enos. Applicants respectfully traverse this rejection as applied to the claims, as amended.

Enos appears to describe a sole that is produced by partially impregnating a fabric, which may be a woven fibrous structure, with a rubber or equivalent composition. The portion 14 of the fabric not impregnated "impart[s] the desired anti-slipping characteristics to the sole while the impregnation with rubber and the like affords the desired protection against moisture." Enos, pg. 2, col. 1, ll. 45-49. The total amount of impregnation of rubber or equivalent composition may "vary between the limits of 10% to 90%." Enos, pg. 2, col. 1, ll. 8-9. The amount of "impregnation [is] controlled so as to leave a substantial portion of the nap or pile in its original unimpregnated condition." Enos, pg. 2, col. 1, ll. 16-18. In other words, Enos appears to describe a fabric layer that is not completely impregnated with rubber or like compositions. As a result of that incomplete impregnation, only the unimpregnated portion 14 of fabric layer is exposed to the ground. Indeed, such an arrangement is shown in Enos, FIG. 3.

In contrast, Applicants claim, in amended claim 1, "a first layer having a ground engaging surface; and a second layer having a ground engaging surface, the second layer comprising a continuous mesh having a first side and a second side, the first side embedded in the first layer and the second side continuously exposed along the ground engaging surface of the first layer." Similar language is recited in Applicants' amended claim 11.

Applicants respectfully submit that Enos fails to anticipate Applicants' amended claims 1 and 11, because Enos fails to describe, at least, "a first layer having a ground engaging surface; *and* a second layer having a ground engaging surface." As described above, Enos expressly

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states that the total impregnation with rubber or like compositions is, at most, 90% of the fiber thickness. Accordingly, the non-impregnated surface portion 14 is the only portion of the foundation 10 that contacts the ground. Indeed, according to Enos, the unimpregnated fabric layer 14, "impart[s] the desired anti-slipping characteristics to the sole." Enos, pg. 2, col. 1, ll. 45-47. Thus, the rubber impregnated surface portion 12 of Enos could not "hav[e] a ground engaging surface." Enos, therefore, has solely a single layer with a ground engaging surface and not first and second ground engaging surface layers, as claimed.

Accordingly, Applicants respectfully submit that amended independent claims 1 and 11 are patentable over Enos under 35 U.S.C. § 102(b). Because claims 2, 6-7, 9-10, 12, 16-17, and 37-44 depend, either directly or indirectly, from amended claims 1 or 11, Applicants respectfully submit that those claims are patentable as well. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-2, 6-7, 9-12, 16-17, and 37-42 under 35 U.S.C. § 102(b), and allowance of claims 43 and 44.

2. Claims 3-4 and 13-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Enos. Applicants respectfully traverse this rejection as applied to the claims, as amended.

As indicated above, Enos fails to anticipate every element of amended claims 1 and 11, from which claims 3-4 and 13-14 depend, respectively. Specifically, at a minimum, Enos does not describe "a first layer having a ground engaging surface; *and* a second layer having a ground engaging surface." Enos' failure to describe the claimed structure is not overcome by what was known in the art at the time of Applicants' invention regarding materials of construction. Thus, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 3-4, and 13-14 under 35 U.S.C. § 103(a).

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3. Claims 1-2, 5, 7-12, 15, 17-20, and 37-42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Zachman in view of Crooker. Applicants respectfully traverse this rejection as applied to the claims, as amended.

Briefly, Zachman appears to describe a safety shoe sole construction 10. Zachman, col. 3, ll. 23-27. The safety shoe sole construction 10 includes a flexible shoe sole 12 and a shoe upper 11 that is mounted on the shoe sole 12 and that extends upwardly therefrom. Zachman, col. 3, ll. 28-31. At least one metallic fabric mesh web 15 is fully embedded between the top and bottom surfaces and the outer periphery 14 of the shoe sole 12. Zachman, col. 3, ll. 34-37. The metallic fabric mesh web 15 purportedly prevents inadvertent and accidental piercing of the shoe sole 12 by various foreign objects, such as nails, spikes, and the like. Zachman, col. 3, ll. 38-40.

Crooker appears to describe a non-skid rubber sole construction. The sole 10 includes, on its outer surface, transverse ribs 12 spaced apart by transverse grooves 13. Crooker, col. 2, ll. 18-21. Each rib 12 has a rounded outer surface contour 14, and extending longitudinally within each is a helical coil 15. Crooker, col. 2, ll. 22-25. The coil 15 is positioned within the rib 12 so that a side portion of the coil 15 is substantially flush with the outer rounded surface 14 of the rib 12. Crooker, col. 2, ll. 28-31. Purportedly, when a shoe employing such a sole 10 is donned, over time the outer portions 14 of the ribs 12 wear away. Crooker, col. 2, ll. 44-46. This wear exposes the outer portions of the coils 15 and thereby provides a plurality of road gripping elements exposed along the wearing surfaces of the ribs 12. Crooker, col. 2, ll. 47-50. With continued use, exposed portions of the coils ultimately wear to expose four wire ends in place of each of the worn away elements. Crooker, col. 2, l. 51 – col. 3, l. 1.

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As an initial matter, Applicants respectfully assert that the proposed combination of Crooker with Zachman would render Zachman unsatisfactory for its intended purpose. As described above, Zachman describes a safety shoe comprising at least one metallic fabric mesh web 15. This web construction is designed to "prevent[] inadvertent and accidental piercing of the shoe sole by . . . nails, spikes, and the like." Zachman, col. 3, ll. 37-38. Thus, it appears that integrity of the mesh is critical to prevent any accidental piercing of the sole. In contrast, Crooker describes a sole embedded with wire coils to provide grip to the wearer while walking on icy or other slippery surfaces. The sole of Crooker is specifically designed to wear quickly, thus exposing the wire coils embedded within. Crooker, col. 2, ll. 47-50. Over time, the wires themselves wear away to leave end pieces that provide a better grip on slippery surfaces. Crooker, col. 2, l. 51 – col. 3, l. 1. In other words, the coils of Crooker are specifically designed to break down during use. Such a coil design employed in the Zachman reference would render the protective qualities of Zachman ineffective by deliberately compromising the integrity of the protective mesh layer. Such a compromise would render Zachman unfit for its intended purpose, and thus, the combination is an improper one, as there is no motivation to combine the two references. See In re Gordon, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

Moreover, even if the Zachman and Crooker references were combinable, the proposed combination still fails to render obvious Applicants' amended claims 1 and 11. As described above, Zachman appears to disclose a metallic fabric mesh web 15 that is fully embedded between the top and bottom surfaces and the outer periphery 14 of the shoe sole 12. Zachman, col. 3, ll. 34-37. Similarly, Crooker appears to disclose a coil 15 positioned within a rib 12 of a sole so that a side portion of the coil 15 is substantially flush with the outer rounded surface 14 of

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the rib 12. Crooker, col. 2, ll. 28-31. According to Crooker, over time, the outer portions 14 of the ribs 12 wear away, only then exposing the coils 15 and thereby providing a plurality of road gripping elements exposed along the wearing surfaces of the ribs 12. Crooker, col. 2, ll. 44-50.

In contrast, Applicants amended claims 1 and 11 recite "a second layer having a ground engaging surface, the second layer comprising a continuous mesh having a first side and a second side, the first side embedded in the first layer and the second side continuously exposed along the ground engaging surface of the first layer." Applicants respectfully assert that the combination of Zachman and Crooker fails to suggest, at least, "a second layer having a ground engaging surface, the second layer comprising *a continuous mesh having a first side and a second side, the first side embedded in the first layer and the second side continuously exposed* along the ground engaging surface of the first layer."

As described, Zachman appears to disclose metal coils embedded in a shoe sole. As such, the coils are not exposed at all. Therefore, the coils of Zachman clearly lack a second side having a continuously exposed ground engaging surface. Crooker, on the other hand, appears to describe a shoe including a number of discrete, individual helical coils, one coil per rib, which are not joined or otherwise connected to each other. Therefore, the helical coils of Crooker should not be considered to be the claimed "continuous mesh." Moreover, even if the discrete helical coils of Crooker were considered to be a "continuous mesh," which they are not, a second side of the helical coils are not "continuously exposed along the ground engaging surface of the first layer." As the sole of Crooker breaks down, only discrete, spaced apart points of the helical coils of Crooker are exposed, not a second side of the mesh. See Crooker, FIG. 3. With prolonged wear, the coils themselves break down, thus exposing the worn tips of the metal coils.

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There is not a spatially connected, continuous mesh layer, having a second exposed ground engaging surface. Thus, the coils of Crooker lack a "*second side continuously exposed* along the ground engaging surface of the first layer;" rather, only discrete, spaced apart points of the coils are exposed.

Accordingly, Applicants respectfully submit that the combination of Zachman and Crooker fails to render obvious Applicants' amended claims 1 and 11. Because claims 2, 5, 7-10, 12, 15, 17-20, and 37-44 depend, either directly or indirectly, from claims 1 or 11, Applicants respectfully assert that those claims are patentable as well. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-2, 5, 7-12, 15, 17-20, and 37-42 under 35 U.S.C. § 103(a), and the allowance of new claims 43 and 44.

4. New claims 43 and 44 are drawn to a substantially planar continuous mesh, as readily apparent from FIGS. 7 and 8, where a mesh with a first side and a second side is shown placed in an injection mold.

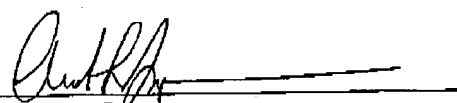
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**CONCLUSION**

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of all grounds of rejection of claims 1-20 and 37-42, and allowance of claims 1-20 and 37-44 in due course. The Examiner is invited to contact Applicants' undersigned representative by telephone at the number listed below to discuss any outstanding issues.

Respectfully submitted,

Date: April 5, 2004  
Reg. No. 51,842  
Tel. No. (617) 310-8671  
Fax No. (617) 790-0100

  
Andrew L. Jagenow  
Attorney for the Applicants  
Testa, Hurwitz & Thibault, LLP  
125 High Street  
Boston, MA 02110

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